

**REMARKS**

Claims 1-20 are currently pending in the application. By this response, no claims are amended, added, or canceled. Applicants respectfully request reconsideration of the rejected claims in view of the following remarks.

***Information Disclosure Statement***

Applicants note that the outstanding Final Office Action does not contain any indication of consideration of the Information Disclosure Statement (IDS) that was submitted on October 11, 2006. Consideration of the IDS is required under 37 C.F.R. 1.97(c) because the IDS was submitted after the mailing of a first office action on the merits but before the mailing of a final rejection or notice of allowance, and the fee of \$180.00 set forth in 37 C.F.R. §1.17(p) was paid.

Accordingly, Applicants respectfully request that the Examiner consider the documents cited in the IDS and indicate such consideration by returning an initialed and signed copy of the PTO-1449 Form with the next official communication.

***35 U.S.C. §102 Rejection***

Claims 8, 11-14, 16, 18, and 20 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0079820 issued to Palsson et al. ("Palsson").

To anticipate a claim, each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference. MPEP §2131. Applicants submit that Palsson does not show each and every feature of the claimed invention.

Independent Claim 8

As previously discussed, the present invention relates to a building board made of OSB (oriented strand board) which can be laid on beams in order to form a subfloor. Non-limiting exemplary implementations of the invention provide an OSB building board for forming subfloors such that the boards can be reliably oriented parallel to one another and connected to one another. Independent claim 8 recites, in pertinent part:

... a first longitudinal edge having a tongue;  
a second longitudinal edge opposite the first longitudinal edge and having a groove bounded by a top lip and a bottom lip;  
...  
wherein a front edge of the tongue of the first longitudinal edge comprises a bevel,  
the bottom lip of the second longitudinal edge has a concave recess over its length, and  
the tongue of the first longitudinal edge has a convex underside which corresponds to the concave recess.

The Examiner asserts that Palsen discloses all of these elements in FIG. 6 and paragraphs [0010] and [0011]. Particularly, the Examiner asserts that Palsen shows “[a] front edge of tongue (13) of the first longitudinal edge comprises a bevel (23)”, and “[t]he bottom lip (A) of the second longitudinal edge has a concave recess over its entire length, and the tongue of the first longitudinal edge has a convex underside...”. Applicants respectfully disagree, and submit that the Examiner is improperly combining elements from different disclosed embodiments in an attempt to arrive at the claimed invention

More specifically, Applicants submit that no single embodiment of Palsen shows a front edge of the tongue of the first longitudinal edge having a bevel, the bottom lip of the second longitudinal edge having a concave recess over its length, and the tongue of the first

longitudinal edge having a convex underside which corresponds to the concave recess, as recited in claim 8.

Instead, Palsson discloses building panels that have tongue and groove connections, none of which contain the above-noted combination of features. For example, FIG. 1 shows embodiments of a connection between first and second corresponding longitudinal edges 2<sup>I</sup> and 2<sup>II</sup>. First longitudinal edge 2<sup>I</sup> has a tongue 11 that corresponds to groove 13 of second longitudinal edge 2<sup>II</sup>. The tongue 11 appears to be convex with a concave upper portion at the tip, and the groove 13 concave. However, there is no showing of a bevel on the front edge of the tongue 11.

FIG. 2, similar to FIG. 1, shows a convex tongue with a concave upper portion at its tip, and a concave groove; however, there is no bevel on the front edge of the tongue. FIGS. 3 and 4 show a tongue and groove connection; however, neither shows a front edge of the tongue of the first longitudinal edge having a bevel, the bottom lip of the second longitudinal edge having a concave recess over its length, and the tongue of the first longitudinal edge having a convex underside which corresponds to the concave recess, as recited in claim 8.

Still referring to Palsson, FIGS. 5 and 6 show embodiments of a different connection between third and fourth corresponding transverse edges 2<sup>III</sup> and 2<sup>IV</sup> of the board. Specifically, FIGS. 5 and 6 show a tongue (not numbered) on edge 2<sup>III</sup> that fits into a groove (not numbered) on edge 2<sup>IV</sup>. The tongue comprises a snapping hook 23 (FIG. 6) or snapping hooks (FIG. 5) that corresponds to a matching undercut 24 (FIG. 6) or undercuts (FIG. 5) of the groove. However, the bottom lip that forms the groove does not have a concave recess over its entire length, and the tongue does not have a convex underside. Instead, as can clearly be seen from FIGS. 5 and 6, the groove and tongue are made up of straight surfaces arranged at angles to

each other. These straight surfaces are not convex (i.e., curved outward) or concave (i.e., curved inward). Also, it is clear that the tongue does not include a bevel. Instead, the tongue only has stepped portions (i.e., snapping hook 23) which do not constitute a bevel. As such, no single embodiment of Palsson includes all of the features recited in claim 8.

Thus, it appears that the Examiner is improperly combining elements from different disclosed embodiments in an attempt to arrive at the claimed invention. For example, the Examiner asserts that “[a] front edge of tongue (13) of the first longitudinal edge comprises a bevel (23)”. However, reference numbers 13 and 23 are found in mutually exclusive embodiments. That is, reference number 13 is shown in FIGS. 1-4, but is not used in FIG. 6. Similarly, reference number 23 is shown in FIG. 6, but not used in FIGS. 1-4. As discussed above, no single embodiment of Palsson shows: a front edge of the tongue of the first longitudinal edge having a bevel, the bottom lip of the second longitudinal edge having a concave recess over its length, and the tongue of the first longitudinal edge having a convex underside which corresponds to the concave recess, as recited in claim 8. Therefore, the rejection is improper and should be withdrawn.

Independent Claim 20

Independent claim 20 recites, in pertinent part:

... wherein the groove on the longitudinal edge is bounded by a top lip and a bottom lip, the bottom lip projects laterally beyond the top lip and has a concave recess over the entire length, the tongue has a convex underside which corresponds to the recess, and the bottom lip has a plurality of spaced apart depressions configured to accommodate a countersunk nail head or screw head.

The Examiner asserts that

... the groove (13) of the second longitudinal edge and second transverse edge comprises a top lip (B) and a bottom lip (A). The bottom lip (A) forms a concave recess inherently capable of accommodating countersunk nail heads or screw heads.

Applicants respectfully disagree and submit that Palsson does not contain the above-noted combination of features.

Initially, Applicants note that the explanation of the rejection does not address the recited features of the claimed invention. That is, the Examiner does not address a *plurality* of *spaced apart* depressions, as recited in claim 20. Instead, the Examiner merely asserts that Palsson shows a concave recess inherently capable of accommodating countersunk nail heads or screw heads. Thus, the rejection fails to address both the *plurality* aspect and the *spaced apart* aspect of the recitation of claim 20. Therefore, the Examiner failed to properly establish a *prima facie* case of anticipation, and the rejection should be withdrawn for at least this reason alone.

In any event, Applicants submit that Palsson does not contain the combination of features recited in claim 20. Instead, Palsson shows, in FIGS. 1 and 2, a groove 13 formed by a bottom lip 14. The bottom lip 14 has a concave recess over its length. However, the bottom lip 14 does not also comprise a plurality of spaced apart depressions configured to accommodate a countersunk nail head or screw head. Thus, even if Palsson has a recess which can accommodate a nail or screw head, Palsson does not also disclose a plurality of depressions that can accommodate a nail or screw head. Claim 20 clearly requires that the bottom lip have both (i) a concave recess over the entire length and (ii) a plurality of spaced apart depressions.

Palsson's bottom lip 14, shown in FIGS. 1 and 2, does not contain both features. Instead, bottom lip 14 only has a concave recess, and does not include a plurality of depressions.

Also, no other embodiment of Palsson shows a bottom lip having a concave recess over the entire length, and, therefore, no other embodiment can arguably anticipate the claimed invention. For example, FIGS. 5 and 6 show a bottom lip (not numbered, but referred to as "A" in the Final Office Action) that has a recess formed of straight surfaces. The recess is not concave over the entire length. Moreover, FIGS. 5 and 6 do not show a plurality of spaced apart depressions in addition to the recess. Thus, Palsson simply does not show the combination of features recited in claim 20, including: the bottom lip projects laterally beyond the top lip and has a concave recess over the entire length, *and* the bottom lip has a plurality of spaced apart depressions configured to accommodate a countersunk nail head or screw head. Therefore, the rejection is improper and should be withdrawn.

*Dependent Claims 11-14, 16, and 18*

Applicants respectfully submit that claims 11-14, 16, and 18 depend from allowable claim 8, and are allowable for at least the same reasons discussed above with respect to claim 8. Moreover, Palsson does not disclose many of the features of these dependent claims.

For example, Palsson does not disclose a recess formed in the tongue of the first longitudinal edge adjacent to the bevel, as recited in claim 11. The Examiner asserts that Palsson's cavity 6 constitutes such a recess. Applicants respectfully disagree and submit that the cavity 6 is not formed in the tongue, as recited in claim 11. Instead, as can be seen in FIG. 6, the cavity 6 is formed in the vertical upper mating surface 25. This mating surface 25 is not

the tongue. Therefore, Palsson does not contain all of the features of claim 11, and the rejection should be withdrawn.

Additionally, Palsson does not disclose a plurality of spaced apart recesses provided along the bottom lip of the second longitudinal edge, as recited in claim 12. First, as discussed above, the Examiner fails to address the *plurality* and *spaced apart* aspects of claim 12. Because the Examiner failed to properly establish a *prima facie* case of anticipation with respect to claim 12, the rejection of claims 12-14 is improper and should be withdrawn.

Applicants submit that, in any event, Palsson does not contain the combination of features recited in claim 12. As discussed above, Palsson does not disclose both (i) the bottom lip of the second longitudinal edge having a concave recess over its length and (ii) a plurality of spaced apart recesses provided along the bottom lip.

Furthermore, regarding claim 18, Palsson does not disclose markings provided on a top side of the board and corresponding to spacing between beams. The Examiner asserts that “the board comprises an upper decorative layer (3) which provides markings on a top side of the board.” Applicants again note that the Examiner has failed to address every feature of the claimed invention. That is, the rejection fails to explain how the markings correspond to spacing between beams, as recited in claim 18. Therefore, the Examiner has failed to establish a *prima facie* case of anticipation, and the rejection of claim 18 should be withdrawn for at least this reason alone.

Notwithstanding the Examiner’s assertion, Applicants submit that Palsson does not disclose markings provided on a top side of the board and corresponding to spacing between beams. There is no mention whatsoever of the spacing of beams in the Palsson disclosure,

much less that markings of the decorative layer 3 correspond to the spacing of beams.

Therefore, the rejection is improper and should be withdrawn.

Accordingly, Applicants respectfully request that the rejection of claims 8, 11-14, 16, 18, and 20 under 35 U.S.C. §102(e) be withdrawn.

### ***35 U.S.C. §103 Rejection***

Claims 1, 2, 6, and 7 were rejected under 35 U.S.C. §103(a) for being unpatentable over Palsson. Claims 3, 9-10, and 19 were rejected under 35 U.S.C. §103(a) for being unpatentable over Palsson in view of U.S. Patent Application Publication No. 2002/0056245 issued to Thiers (“Thiers”). Claims 4, 5, 15, and 17 were rejected under 35 U.S.C. §103(a) for being unpatentable over Palsson in view of U.S. Patent Application Publication No. 2003/0035921 issued to Kornicer et al. (“Kornicer”). These rejections are respectfully traversed.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §2142.

#### ***Claims 1, 2, 6 and 7 in view of Palsson***

Independent claim 1 recites, *inter alia*, the tongue on the longitudinal edge comprises a bevel and a recess adjacent the bevel. Palsson does not teach or suggest these features.



Instead, as discussed above, Palsson shows a cavity 6 in the upper mating surface 25. The tongue does not comprise a recess and bevel, as required in claim 1. Instead, the upper mating surface 25 comprises the cavity 6. As such, Palsson does not teach or suggest each and every feature of claim 1. Therefore, the rejection is improper and should be withdrawn.

Applicants respectfully submit that claims 2, 6, and 7 depend from allowable claim 1, and are allowable for at least the same reasons discussed above with respect to claim 1. Moreover, Palsson does not teach or suggest many of the features of these dependent claims.

For example, Palsson does not teach or suggest the bottom lip of the groove, on the longitudinal and/or transverse side, has depressions, which are spaced apart parallel to one another, for accommodating a nail head or screw head, as recited in claim 7. The Examiner asserts that Palsson does disclose these features, and refers to the rejection of claims 12-14 and 20 (see paragraph 14 of the Final Office Action). Applicants again note that the Examiner has failed to address all of the features recited in the claimed invention, and, therefore, has failed to establish a *prima facie* case of obviousness. Moreover, the rejection fails to address the “spaced apart” and “parallel” language of the claim. For this reason alone the rejection is improper and should be withdrawn. In any event, Palsson, for the reasons discussed above, does not disclose the features of the claimed invention.

Accordingly, Applicants respectfully request that the rejection over claims 1, 2, 6 and 7 be withdrawn.

*Claims 3, 9, 10, and 19 in view of Palsson and Thiers*

Applicants respectfully submit that claims 3 and 19 depend from allowable claim 1, and are allowable for at least the same reasons discussed above with respect to claim 1. As

discussed above, Palsson does not teach or suggest that a tongue on the longitudinal edge comprises a bevel and a recess adjacent the bevel, as recited in claim 1. Thiers does not compensate for the deficiencies of Palsson with respect to these features. Instead, Thiers shows a panel having opposed longitudinal edges 3, 4 (FIG. 3). The first edge 3 has a tongue 8, and the second edge 4 has a groove 9 that corresponds to the tongue. Adjacent panels connected by a respective tongue 8 and groove 9 are locked in both the vertical and horizontal direction. However, the tongue 8 does not comprise a bevel and a recess adjacent the bevel, as recited in claim 1. Therefore, no proper combination of the applied references teaches or suggests all of the features of the claimed invention.

Applicants respectfully submit that claims 9 and 10 depend from allowable claim 8, and are allowable for at least the same reasons discussed above with respect to claim 8. As discussed above, Palsson does not disclose a front edge of the tongue of the first longitudinal edge having a bevel, the bottom lip of the second longitudinal edge having a concave recess over its length, and the tongue of the first longitudinal edge having a convex underside which corresponds to the concave recess, as recited in claim 8. Thiers does not compensate for the deficiencies of Palsson with respect to these features. Thiers's tongue 8 and groove 9 are not arranged such that a front edge of the tongue of the first longitudinal edge comprises a bevel, the bottom lip of the second longitudinal edge has a concave recess over its length, and the tongue of the first longitudinal edge has a convex underside which corresponds to the concave recess. Therefore, no proper combination of the applied references teaches or suggests all of the features of the claimed invention.

Accordingly, Applicants respectfully request that the rejection of claims 3, 9, 10, and 19 under 35 U.S.C. §103(a) be withdrawn.

Claims 4, 5, 15, and 17 in view of Palsson and Kornicer

Applicants respectfully submit that claims 4 and 5 depend from allowable claim 1, and are allowable for at least the same reasons discussed above with respect to claim 1. As discussed above, Palsson does not teach or suggest all of the features of claim 1. Kornicer does not compensate for the deficiencies of Palsson with respect to such features. Kornicer shows a layered board 10, but makes no mention of a tongue and groove connection. Therefore, no proper combination of the applied references can arguably teach or suggest all of the features of the claimed invention.

Applicants respectfully submit that claims 15 and 17 depend from allowable claim 8, and are allowable for at least the same reasons discussed above with respect to claim 8. As discussed above, Palsson does not disclose a front edge of the tongue of the first longitudinal edge having a bevel, the bottom lip of the second longitudinal edge having a concave recess over its length, and the tongue of the first longitudinal edge having a convex underside which corresponds to the concave recess, as recited in claim 8. Kornicer does not compensate for the deficiencies of Palsson with respect to these features. Kornicer shows a layered board 10, but makes no mention of a tongue and groove connection. Therefore, no proper combination of the applied references can arguably teach or suggest all of the features of the claimed invention.

Accordingly, Applicants respectfully request that the rejection of claims 4, 5, 15, and 17 under 35 U.S.C. §103(a) be withdrawn.

### CONCLUSION

In view of the foregoing remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 19-0089.

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